



THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re application of:

Ian M. Drysdale

Serial No.: 09/466,271

Filed: December 17, 1999

For: METHOD AND DEVICE FOR PERFORMING CARD TRANSACTIONS

Attorney Docket No.: FDC 0135 PUS

Group Art Unit: 3628

Examiner: Kanof, Pedro R.

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
U.S. Patent & Trademark Office
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Sir:

This is an appeal brief from the final rejection of claims 1-21 of the Final Office
Action dated March 25, 2003. This application was filed on December 17, 1999.

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I. REAL PARTY IN INTEREST


The real party in interest is First Data Corporation, a corporation organized and existing under the laws of the state of Delaware, and having a place of business at 401 Hackensack Avenue, Hackensack, New Jersey 07601, as set forth in the assignment recorded in the U.S. Patent and Trademark Office on March 27, 2001, Reel 011419/Frame 0937.

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this paper, including all enclosures referred to herein, is being deposited with the United States Postal Service as first-class mail, postage pre-paid, in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, U.S. Patent & Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450 on:

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II. RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences known to appellant, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-21 stand finally rejected and are the subject of this appeal. These claims are reproduced in Appendix A.

IV. STATUS OF AMENDMENTS

No amendment after final rejection was filed.

V. SUMMARY OF THE INVENTION

The invention provides a method of performing a card transaction, the method comprising accessing a web server using a transaction device (10), wherein the web server includes commands for processing the transaction; and entering a transaction card into a card reader (14) of the transaction device in order to enter transaction information associated with the card into the web server, wherein the transaction device does not utilize proprietary software of a merchant service provider to complete the transaction. (See, for example, Figures 1 and 2, and the specification at page 4, line 1 through page 6, line 2).

In another embodiment, the invention provides a method of performing a card transaction, the method comprising accessing a web server using a point of service terminal (10) having a web browser and a card reader (14), wherein the web server includes commands for obtaining authorization of the transaction; entering a transaction card into the card reader in order to enter an account number associated with the card into the web server; responding to prompts generated by the web server using the terminal; and obtaining authorization for the transaction through the web server, wherein the point of service terminal does not utilize proprietary software of a merchant service provider to complete the transaction. (See, for example, Figures 1 and 2, and the specification at page 4, line 1 through page 6, line 2).

In a third embodiment, the invention provides a point of service terminal (10) for performing a card transaction. The terminal comprises a central processing unit (12) having a web browser for accessing a web server on the Internet (24), and a card reader (14) in communication with the central processing unit for receiving a transaction card and entering transaction information associated with the card into the web server. The point of service terminal does not utilize proprietary software of a merchant service provider to complete the transaction. (See, for example, Figures 1 and 2, and the specification at page 4, line 1 through page 6, line 2).

VI. ISSUES

1. Whether the Examiner has established that claim 21 is unpatentable under 35 U.S.C. § 112, first paragraph.
2. Whether the Examiner has made a *prima facie* case that claims 1-3, 5-15 and 17-19 are unpatentable under 35 U.S.C. § 103(a) over U.S. Patent No. 5,850,442 to Muftic (hereinafter Muftic).

3. Whether the Examiner has made a *prima facie* case that claims 4, 16 and 20 are unpatentable under 35 U.S.C. § 103(a) over Muftic in view of U.S. Patent No. 5,987,498 to Athing et al. (hereinafter Athing).

VII. GROUPING OF CLAIMS

Appellants contend that the claims do not stand or fall together. In particular, Appellants contend the claims may be grouped as follows:

1. Claims 1-10 and 17-21 (Group 1).
2. Claim 11 (Group 2).
3. Claims 12-16 (Group 3).

Groups 1, 2 and 3, as well as select dependent claims within the Groups, are believed to be separately patentable, as argued below in detail. In particular, the claims in each of the Groups provide limitations that are separately patentable from the other Groups over the cited art.

VIII. ARGUMENT

1. **The Examiner Has Failed to Make a *Prima Facie* Case That Claim 21 Is Unpatentable Under 35 U.S.C. § 112, First Paragraph**

The Examiner has rejected claim 21 as being unpatentable under 35 U.S.C. § 112, first paragraph. However, the Examiner has failed to establish that rejected claim 21 fails to meet the requirements of 35 U.S.C. § 112, first paragraph and the rejection should, therefore, be reversed. Claim 21 depends directly from claim 1 and provides the further recitation that the web server processes the transaction without proprietary software.

The Examiner contends that the specification, as originally filed, does not provide support for the recitation in claim 21 that “the web server processes the transaction without proprietary software.” (Final Office Action mailed March 25, 2003 on page 2, ll. 11-15). However, as noted in the Amendment mailed September 20, 2002, the specification on page 2, ll. 12-14 recites, “ [b]ecause neither a proprietary operating system nor a proprietary network are required, this method is less costly than prior methods that involve such systems and networks.” The specification further recites on page 5, ll. 23-26, “[f]urthermore, because the terminal 10 accesses the Internet 24 through an ISP, instead of accessing a proprietary network of the MSP, the terminal 10 need only include software necessary to access the Internet.” In at least one conventional example, a web server implements proprietary software in connection with operating system software and network software. (See, for example, Muftic, Figure 2 and col. 9, l. 56 - col. 10, l. 15). In contrast, claim 21 provides the web server processes the transaction without proprietary software. “There is no requirement that the words in the claim must match those used in the specification disclosure.” (See, MPEP § 2173.05(d)). As such, the specification describes the claimed subject matter in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention and the rejection should, therefore, be reversed.

The Examiner further contends that “it is not clear how transactions performed by using different merchant service providers (e.g., American Express, VISA, Master, Discover, etc.) can be completed without respective providers proprietary software.” (Final Office Action mailed March 25, 2003 on page 2, l. 20 - page 3, l. 2). However, the Examiner has mischaracterized the teaching of claim 21. Claim 21 provides that “the web server processes the transaction without proprietary software.” As is recited in the specification on page 5, ll. 23-26, “[f]urthermore, because the terminal 10 accesses the Internet 24 through an ISP, instead of accessing a proprietary network of the MSP, the terminal 10 need only include software necessary to access the Internet.” Thus, American Express, VISA, Master, Discover,

etc. may implement proprietary software to perform transactions in connection with hardware other than the web server (e.g., terminals or other devices that are located at American Express, VISA, Master, Discover, etc.) instead of only in connection with web servers. As such, the web server processes the transaction without proprietary software when the invention of claim 21 is implemented. The rejection should, therefore, be reversed.

2. The Examiner Has Failed to Make a *Prima Facie* Case That Claims 1-3, 5-15 and 17-19 Are Unpatentable Under 35 U.S.C. § 103(a) Over Muftic

The Examiner has rejected claims 1-3, 5-10 and 17-19 of Group 1, claim 11 of Group 2, and claims 12-15 of Group 3, as being obvious under 35 U.S.C. § 103(a) over Muftic. However, the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a) and the rejection should, therefore, be reversed. In that regard:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.

Manual of Patent Examining Procedure (MPEP), 8th Edition, August 2001, revised February 2003, § 2143 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

Furthermore, "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." MPEP § 2141.02 (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)).

A. The Examiner improperly rejected Group 1 (claims 1-10 and 17-21) as being unpatentable over Muftic

The Examiner has failed to establish that Muftic teaches or suggests all the claim limitations of the present invention. In particular, independent claim 1 concerns a method of performing a card transaction and provides for accessing a web server using a transaction device, wherein the transaction device does not utilize proprietary software of a merchant service provider to complete the transaction. Indeed, the Examiner has admitted that Muftic fails to disclose the features related to a transaction device or point of service terminal that does not utilize proprietary software of a merchant service provider to complete the transaction described above with respect to claim 1. (Final Office Action mailed March 25, 2003 on page 3, ll. 19-20). Thus, Muftic falls short of the invention claimed in claim 1. Therefore, the Examiner has failed to provide evidence to support a proper rejection under 35 U.S.C. § 103(a) and the rejection should be reversed.

Instead, the Examiner contends that Muftic discloses one of the advantages [of Muftic] is to permit world wide electronic commercial transactions to be implemented in a highly secure manner over an open network. (Final Office Action mailed March 25, 2003 on page 4, ll. 1-3). The Examiner further contends that it would have been within the level of ordinary skill in the art to install proprietary software to a merchant service provider server to permit world wide electronic commercial transactions to be implemented over an open network, and in this configuration, the transaction device/point of service terminals would not utilize proprietary software of a merchant service provider to complete the transaction. (Final Office Action mailed March 25, 2003 on page 4, ll. 3-8).

However, “if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teaching of the references are not sufficient to render the claims *prima facie* obvious.” (MPEP

§ 2143.01 (citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)). In this case, Muftic discloses, “a network that is extended to include a public key infrastructure and electronic transactions [that] can be securely performed utilizing smart token technology.” (Muftic, Abstract). Muftic further discloses that the “invention is directed to the field of communication systems and more particularly to communication systems which utilizes [sic] smart tokens, such [as] smart cards or PCMCIA cards, and a public key infrastructure for enabling secure electronic transactions to occur over an open network.” (Muftic, Technical Field, col. 1, ll. 18-22). Muftic also discloses that “the Applicant [i.e., the merchant] acquires Public Key Infrastructure (PKI) and smart token software and installs it on his system and acquires a smart token.” (Muftic, col. 12, ll. 17-21). As such, the modification urged by the Examiner would change the principle of operation of the prior art invention of Muftic. Muftic teaches away from modification as suggested by the Examiner. Therefore, the Examiner has failed to provide evidence to support a proper rejection under 35 U.S.C. § 103(a) and the rejection should be reversed.

Moreover, “[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. ‘The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.’” (See, MPEP § 2143.01, citing *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)). As discussed above, the Examiner admits that Muftic fails to provide the explicit teaching of the claimed invention.

Furthermore, the Examiner has failed to provide the motivation to modify the teaching of Muftic as is required for a *prima facie* case of obviousness under 35 U.S.C. § 103(a). The mere fact that references can be combined or modified, which Applicant does not

agree is the case with respect to the cited reference, does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination or modification. (See, MPEP § 2143.01). Here, rather than suggesting the desirability of the Examiner's proposed modification, Muftic actually teaches away from such a modification.

The Examiner has failed to cite any specific understanding of one skilled in the art that would motivate him to make the modification. Instead, the Examiner has used impermissible hindsight to modify the teachings of Muftic to attempt to piece together the Applicant's invention. The teaching or suggestion to make the claimed combination must be found in the prior art, not in the applicant's disclosure. (See, MPEP § 2143; see also, *In re Dembiczak*, 175 F.3d at 994, 999 (Fed. Cir. 1999) ("Combining prior art references without evidence of ... suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.")). As discussed above, Muftic fails to disclose, teach or suggest the present invention, and, to the contrary, teaches against the present invention.

In addition, the Muftic reference cited by the Examiner fails to recognize the problem addressed by the Applicants' claimed invention (i.e., as stated in the presently pending application on page 1, ll. 19-24, "because the [proprietary] software is installed directly on the terminal, any revisions to the software must be downloaded to or otherwise installed on the terminal. Such revisions are therefore time-consuming and costly to perform. Furthermore, installation of some software revisions may be delayed or never accomplished.")). In contrast, Muftic is directed to the field of communication systems and more particularly to communication systems which utilize smart tokens, such as smart cards or PCMCIA cards, and a public key infrastructure for enabling secure electronic transactions to occur over an open network, and, as such, fails to teach a method of performing a card transaction that provides for accessing a web server using a transaction device, wherein the transaction device does not utilize proprietary software of a merchant service provider to complete the transaction as

presently claimed. Therefore, Muftic is directed to a different problem than is addressed by the present invention. As such, Muftic fails to provide any suggestion or motivation for the present invention and the Examiner has failed to make a *prima facie* case of obviousness as is required under 35 U.S.C. § 103.

The Examiner further contends that the smart token technology software disclosed by Muftic is not the proprietary software of a merchant service provider, but the proprietary software of a software company which produced [the software]. (Final Office Action mailed March 25, 2003 on page 7, l. 19 - page 8, l. 5). However, the Examiner has mischaracterized the teaching of Muftic. Proprietary is defined as “held as the property of a private owner.” (See, for example, Webster’s Third New International Dictionary, 1986, page 1819, a copy of which is provided in the Appendix for reference). Muftic discloses that “[i]f Applicant [i.e., the merchant] has not already acquired the software, the Applicant [i.e., merchant] acquires Public Key Infrastructure (PKI) and smart token software and installs it on his system (630) and acquires a smart token.” (Muftic at col. 12, ll. 17-22). As such, contrary to the Examiner’s urging, the smart token technology software disclosed by Muftic is proprietary software of a merchant service provider.

Regarding claims which depend from claim 1, Applicant contends that these claims are patentable for at least the same reasons that claim 1 is patentable.

For these reasons, the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) for the rejection of the claims of Group 1, and the rejection should be reversed.

**B. The Examiner improperly rejected Group 2 (claim 11)
as being unpatentable over Muftic**

The Examiner has failed to establish that Muftic teaches or suggests all the claim limitations of the present invention. In particular, independent claim 11 concerns a method of performing a card transaction using a point of service terminal and provides for accessing a web server using the point of service terminal, wherein the point of service terminal does not utilize proprietary software of a merchant service provider to complete the transaction. Indeed, the Examiner has admitted that Muftic fails to disclose the features related to a point of service terminal that does not utilize proprietary software of a merchant service provider to complete the transaction described above with respect to claim 11. (Final Office Action mailed March 25, 2003 on page 5, ll. 3-4). Thus, Muftic falls short of the invention claimed in claim 11. Therefore, the Examiner has failed to provide evidence to support a proper rejection under 35 U.S.C. § 103(a) and the rejection should be reversed.

Instead, the Examiner contends that Muftic discloses one of the advantages [of Muftic] is to permit world wide electronic commercial transactions to be implemented in a highly secure manner over an open network. (Final Office Action mailed March 25, 2003 on page 5, ll. 4-6). The Examiner further contends that it would have been within the level of ordinary skill in the art to install proprietary software to a merchant service provider server to permit world wide electronic commercial transactions to be implemented over an open network, and in this configuration, the transaction device/point of service terminals would not utilize proprietary software of a merchant service provider to complete the transaction. (Final Office Action mailed March 25, 2003 on page 5, ll. 7-11).

However, "if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teaching of the references are not sufficient to render the claims *prima facie* obvious." (MPEP

§ 2143.01 (citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)). In this case, Muftic discloses, “a network that is extended to include a public key infrastructure and electronic transactions [that] can be securely performed utilizing smart token technology.” (Muftic, Abstract). Muftic further discloses that the “invention is directed to the field of communication systems and more particularly to communication systems which utilizes [sic] smart tokens, such [as] smart cards or PCMCIA cards, and a public key infrastructure for enabling secure electronic transactions to occur over an open network.” (Muftic, Technical Field, col. 1, ll. 18-22). Muftic also discloses that “the Applicant [i.e., the merchant] acquires Public Key Infrastructure (PKI) and smart token software and installs it on his system and acquires a smart token.” (Muftic, col. 12, ll. 17-21). As such, the modification urged by the Examiner would change the principle of operation of the prior art invention of Muftic. Muftic teaches away from modification as suggested by the Examiner. Therefore, the Examiner has failed to provide evidence to support a proper rejection under 35 U.S.C. § 103(a) and the rejection should be reversed.

Moreover, “[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. ‘The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.’” (See, MPEP § 2143.01, citing *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)). As discussed above, the Examiner admits that Muftic fails to provide the explicit teaching of the claimed invention.

Furthermore, the Examiner has failed to provide the motivation to modify the teaching of Muftic as is required for a *prima facie* case of obviousness under 35 U.S.C. § 103(a). The mere fact that references can be combined or modified, which Applicant does not

agree is the case with respect to the cited reference, does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination or modification. (See, MPEP § 2143.01). Here, rather than suggesting the desirability of the Examiner's proposed modification, Muftic actually teaches away from such a modification.

The Examiner has failed to cite any specific understanding of one skilled in the art that would motivate him to make the modification. Instead, the Examiner has used impermissible hindsight to modify the teachings of Muftic to attempt to piece together the Applicant's invention. The teaching or suggestion to make the claimed combination must be found in the prior art, not in the applicant's disclosure. (See, MPEP § 2143; see also, *In re Dembiczak*, 175 F.3d at 994, 999 (Fed. Cir. 1999) ("Combining prior art references without evidence of ... suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.")). As discussed above, Muftic fails to disclose, teach or suggest the present invention, and, to the contrary, teaches against the present invention.

In addition, the Muftic reference cited by the Examiner fails to recognize the problem addressed by the Applicants' claimed invention (i.e., as stated in the presently pending application on page 1, ll. 19-24, "because the [proprietary] software is installed directly on the terminal, any revisions to the software must be downloaded to or otherwise installed on the terminal. Such revisions are therefore time-consuming and costly to perform. Furthermore, installation of some software revisions may be delayed or never accomplished."). In contrast, Muftic is directed to the field of communication systems and more particularly to communication systems which utilize smart tokens, such as smart cards or PCMCIA cards, and a public key infrastructure for enabling secure electronic transactions to occur over an open network, and, as such, fails to teach a method of performing a card transaction using a point of service terminal and that provides for accessing a web server using the point of service terminal, wherein the point of service terminal does not utilize proprietary software of a

merchant service provider to complete the transaction as presently claimed. Therefore, Muftic is directed to a different problem than is addressed by the present invention. As such, Muftic fails to provide any suggestion or motivation for the present invention and the Examiner has failed to make a *prima facie* case of obviousness as is required under 35 U.S.C. § 103.

The Examiner further contends that the smart token technology software disclosed by Muftic is not the proprietary software of a merchant service provider, but the proprietary software of a software company which produced [the software]. (Final Office Action mailed March 25, 2003 on page 7, l. 19 - page 8, l. 5). However, the Examiner has mischaracterized the teaching of Muftic. Proprietary is defined as "held as the property of a private owner." (See, for example, Webster's Third New International Dictionary, 1986, page 1819, a copy of which is provided in the Appendix for reference). Muftic discloses that "[i]f Applicant [i.e., the merchant] has not already acquired the software, the Applicant [i.e., merchant] acquires Public Key Infrastructure (PKI) and smart token software and installs it on his system (630) and acquires a smart token." (Muftic at col. 12, ll. 17-22). As such, contrary to the Examiner's urging, the smart token technology software disclosed by Muftic is proprietary software of a merchant service provider.

For these reasons, the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) for the rejection of claim 11 of Group 2, and the rejection should be reversed.

**C. The Examiner improperly rejected Group 3 (claims 12-16)
as being unpatentable over Muftic**

Here, the Examiner has failed to establish that Muftic teaches or suggests all the claim limitations of the present invention. In particular, independent claim 12 concerns a point of service terminal for performing a card transaction and provides for accessing a web server using the point of service terminal, wherein the point of service terminal does not utilize proprietary software of a merchant service provider to complete the transaction. Indeed, the Examiner has admitted that Muftic fails to disclose the features related to a point of service terminal that does not utilize proprietary software of a merchant service provider to complete the transaction described above with respect to claim 12. (Final Office Action mailed March 25, 2003 on page 3, ll. 19-20). Thus, Muftic falls short of the invention claimed in claim 12. Therefore, the Examiner has failed to provide evidence to support a proper rejection under 35 U.S.C. § 103(a) and the rejection should be reversed.

Instead, the Examiner contends that Muftic discloses one of the advantages [of Muftic] is to permit world wide electronic commercial transactions to be implemented in a highly secure manner over an open network. (Final Office Action mailed March 25, 2003 on page 4, ll. 1-3). The Examiner further contends that it would have been within the level of ordinary skill in the art to install proprietary software to a merchant service provider server to permit world wide electronic commercial transactions to be implemented over an open network, and in this configuration, the transaction device/point of service terminals would not utilize proprietary software of a merchant service provider to complete the transaction. (Final Office Action mailed March 25, 2003 on page 4, ll. 3-8).

However, "if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teaching of the references are not sufficient to render the claims *prima facie* obvious." (MPEP

§ 2143.01 (citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)). In this case, Muftic discloses, “a network that is extended to include a public key infrastructure and electronic transactions [that] can be securely performed utilizing smart token technology.” (Muftic, Abstract). Muftic further discloses that the “invention is directed to the field of communication systems and more particularly to communication systems which utilizes [sic] smart tokens, such [as] smart cards or PCMCIA cards, and a public key infrastructure for enabling secure electronic transactions to occur over an open network.” (Muftic, Technical Field, col. 1, ll. 18-22). Muftic also discloses that “the Applicant [i.e., the merchant] acquires Public Key Infrastructure (PKI) and smart token software and installs it on his system and acquires a smart token.” (Muftic, col. 12, ll. 17-21). As such, the modification urged by the Examiner would change the principle of operation of the prior art invention of Muftic. Muftic teaches away from modification as suggested by the Examiner. Therefore, the Examiner has failed to provide evidence to support a proper rejection under 35 U.S.C. § 103(a) and the rejection should be reversed.

Moreover, “[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. ‘The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.’” (See, MPEP § 2143.01, citing *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)). As discussed above, the Examiner admits that Muftic fails to provide the explicit teaching of the claimed invention.

Furthermore, the Examiner has failed to provide the motivation to modify the teaching of Muftic as is required for a *prima facie* case of obviousness under 35 U.S.C. § 103(a). The mere fact that references can be combined or modified, which Applicant does not

agree is the case with respect to the cited reference, does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination or modification. (See, MPEP § 2143.01). Here, rather than suggesting the desirability of the Examiner's proposed modification, Muftic actually teaches away from such a modification.

The Examiner has failed to cite any specific understanding of one skilled in the art that would motivate him to make the modification. Instead, the Examiner has used impermissible hindsight to modify the teachings of Muftic to attempt to piece together the Applicant's invention. The teaching or suggestion to make the claimed combination must be found in the prior art, not in the applicant's disclosure. (See, MPEP § 2143; see also, *In re Dembiczak*, 175 F.3d at 994, 999 (Fed. Cir. 1999) ("Combining prior art references without evidence of ... suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.")). As discussed above, Muftic fails to disclose, teach or suggest the present invention, and, to the contrary, teaches against the present invention.

In addition, the Muftic reference cited by the Examiner fails to recognize the problem addressed by the Applicants' claimed invention (i.e., as stated in the presently pending application on page 1, ll. 19-24, "because the [proprietary] software is installed directly on the terminal, any revisions to the software must be downloaded to or otherwise installed on the terminal. Such revisions are therefore time-consuming and costly to perform. Furthermore, installation of some software revisions may be delayed or never accomplished.")). In contrast, Muftic is directed to the field of communication systems and more particularly to communication systems which utilize smart tokens, such as smart cards or PCMCIA cards, and a public key infrastructure for enabling secure electronic transactions to occur over an open network, and, as such, fails to teach a point of service terminal for performing a card transaction and that provides for accessing a web server using the point of service terminal, wherein the point of service terminal does not utilize proprietary software of a merchant

service provider to complete the transaction. Therefore, Muftic is directed to a different problem than is addressed by the present invention. As such, Muftic fails to provide any suggestion or motivation for the present invention and the Examiner has failed to make a *prima facie* case of obviousness as is required under 35 U.S.C. § 103.

The Examiner further contends that the smart token technology software disclosed by Muftic is not the proprietary software of a merchant service provider, but the proprietary software of a software company which produced [the software]. (Final Office Action mailed March 25, 2003 on page 7, l. 19 - page 8, l. 5). However, the Examiner has mischaracterized the teaching of Muftic. Proprietary is defined as “held as the property of a private owner.” (See, for example, Webster’s Third New International Dictionary, 1986, page 1819, a copy of which is provided in the Appendix for reference). Muftic discloses that “[i]f Applicant [i.e., the merchant] has not already acquired the software, the Applicant [i.e., merchant] acquires Public Key Infrastructure (PKI) and smart token software and installs it on his system (630) and acquires a smart token.” (Muftic at col. 12, ll. 17-22). As such, contrary to the Examiner’s urging, the smart token technology software disclosed by Muftic is proprietary software of a merchant service provider.

Regarding the claims which depend from claim 12, Applicant contends that these claims are patentable for at least the same reasons that claim 12 is patentable.

For these reasons, the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) for the rejection of the claims of Group 3, and the rejection should be reversed.

3. The Examiner Has Failed to Make a *Prima Facie* Case That Claims 4, 16 and 20 Are Unpatentable Under 35 U.S.C. § 103(a) Over Muftic in view of Athing

The Examiner has rejected claims 4 and 20 of Group 1 and claim 16 of Group 3, as being obvious under 35 U.S.C. § 103(a) over Muftic in view of Athing. However, the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a) and the rejection should, therefore, be reversed. In that regard:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.

Manual of Patent Examining Procedure (MPEP), 8th Edition, August 2001, revised February 2003, § 2143 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

In particular, as discussed above in connection with the rejection of claims 1 and 12 under 35 U.S.C. § 103(a), the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) for the rejection of independent claims 1 and 12. Claim 4 depends indirectly from claim 1 and further provides for entering additional transaction information using a touch-sensitive screen of the transaction device. Claim 16 depends indirectly from claim 12 and further provides the display device comprises a touch-sensitive screen. Claim 20 depends indirectly from claim 1 and further provides for an electronic signature using a pen and the touch-sensitive screen. Applicant contends that these claims are patentable for at least the same reasons that claims 1 and 12 are patentable.

Furthermore, the Examiner asserts that “the use of a touch-sensitive screen is well known and the use of an electronic pen is also well known in the art. Thus, it would have been within the level of ordinary skill in the art to employ these well-known features to the method of Muftic.” (Final Office Action mailed March 25, 2003 on page 7, ll. 8-10). However, the Examiner uses impermissible hindsight to modify the teachings of Muftic with the teaching of Athing to attempt to piece together the Applicant’s invention. The teaching or suggestion to make the claimed combination must be found in the prior art, not in the applicant’s disclosure. (See, MPEP § 2143; see also, *In re Dembiczak*, 175 F.3d at 994, 999 (Fed. Cir. 1999) (“Combining prior art references without evidence of ... suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.”)). Nowhere has the Examiner provided evidence from either of the cited references for a suggestion, teaching, or motivation for the claimed invention.

For these reasons, the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) for the rejection of claims 4, 16 and 20, and the rejection should be reversed

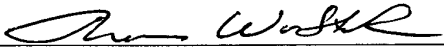
IX. CONCLUSION

The Examiner rejected claim 21 as being unpatentable under 35 U.S.C. § 112, first paragraph. However, the Examiner has failed to establish that rejected claim 21 fails to meet the requirements of 35 U.S.C. § 112, first paragraph. In particular, the specification, as originally filed, provides support for all of the claim recitations, and the specification, as originally filed, conveys to one of ordinary skill in the art how transactions performed can be completed when the web server processes the transactions without proprietary software. Therefore, the final rejection of claim 21 should be reversed.

The Examiner rejected claims 1-20 under 35 U.S.C. § 103(a). However, the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a). In particular, the reference cited by the Examiner fails to teach or suggest all the elements of presently pending independent claims 1, 11 and 12. Furthermore, Muftic teaches away from a method or point of service terminal for performing a card transaction and providing for accessing a web server using a transaction device, wherein the transaction device or point of service terminal does not utilize proprietary software of a merchant service provider to complete the transaction, as recited in presently pending independent claims 1, 11 and 12. Dependent claims 2-10 and 13-20 are patentable for at least the same reasons that claims 1 and 12 are patentable. Therefore, the final rejection of claims 1-21 should be reversed.

The fee of \$320 as applicable under the provisions of 37 C.F.R. § 1.17(c) is enclosed. Please charge any additional fee or credit any overpayment in connection with this filing to our Deposit Account No. 02-3978. A duplicate of this notice is enclosed for this purpose.

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Enclosures - Appendix A - Claims On Appeal, Appendix B - Webster's Third New International Dictionary, 1986, page 1819

X. APPENDIX A - CLAIMS ON APPEAL

1 1. A method of performing a card transaction, the method comprising:
2 accessing a web server using a transaction device, wherein the web server
3 includes commands for processing the transaction; and
4 entering a transaction card into a card reader of the transaction device in order
5 to enter transaction information associated with the card into the web server;
6 wherein the transaction device does not utilize proprietary software of a
7 merchant service provider to complete the transaction.

1 2. The method of claim 1 wherein accessing a web server comprises accessing
2 a web page of the web server, and wherein the web page includes commands for processing
3 the transaction.

1 3. The method of claim 1 further comprising entering additional transaction
2 information into the web server.

1 4. The method of claim 3 wherein entering additional transaction information
2 includes entering additional transaction information using a touch-sensitive screen of the
3 transaction device.

1 5. The method of claim 3 wherein entering additional transaction information
2 includes entering additional transaction information using a keypad of the transaction device.

1 6. The method of claim 1 further comprising displaying information on a
2 display device of the transaction device.

1 7. The method of claim 6 wherein displaying information includes displaying
2 an advertisement downloaded from the Internet.

1 8. The method of claim 6 wherein displaying information includes displaying
2 an electronic coupon downloaded from the Internet.

1 9. The method of claim 1 further comprising obtaining authorization for the
2 transaction through the web server.

1 10. The method of claim 1 further comprising updating the commands of the
2 web server.

1 11. A method of performing a card transaction, the method comprising:
2 accessing a web server using a point of service terminal having a web browser
3 and a card reader, wherein the web server includes commands for obtaining authorization of
4 the transaction;

5 entering a transaction card into the card reader in order to enter an account
6 number associated with the card into the web server;

7 responding to prompts generated by the web server using the terminal; and

8 obtaining authorization for the transaction through the web server;

9 wherein the point of service terminal does not utilize proprietary software of a
10 merchant service provider to complete the transaction.

1 12. A point of service terminal for performing a card transaction, the terminal
2 comprising:

3 a central processing unit having a web browser for accessing a web server on
4 the Internet; and

5 a card reader in communication with the central processing unit for receiving
6 a transaction card and entering transaction information associated with the card into the web
7 server;

8 wherein the point of service terminal does not utilize proprietary software of a
9 merchant service provider to complete the transaction.

1 13. The point of service terminal of claim 12 further comprising a data entry
2 device in communication with the central processing unit for entering additional transaction
3 information into the web server.

1 14. The point of service terminal of claim 13 wherein the data entry device is
2 a keypad.

1 15. The point of service terminal of claim 12 further comprising a display
2 device in communication with the central processing unit for displaying information
3 downloaded from the Internet.

1 16. The point of service terminal of claim 15 wherein the display device
2 comprises a touch-sensitive screen.

1 17. The method of claim 1 wherein the card transaction involves a smart card,
2 a charge card, a credit card or a debit card.

1 18. The method of claim 1 wherein the transaction device comprises a point of
2 service terminal at a merchant or retail location.

1 19. The method of claim 1 further comprising transmitting information to and
2 from a merchant service provider.

1 20. The method of claim 4 further comprising providing an electronic signature
2 using a pen and the touch-sensitive screen.

1 21. The method of claim 1 wherein the web server processes the transaction
2 without proprietary software.

Webster's
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pro-prio *mo-tu* \ˈprōprē, ɔˈmō(t)əd/ *adv* [L. by one's own motion] : by one's own motion ; on one's own initiative
pro-prio-spinal \ˈprōprēō + \əd/ *adj* [*proprio-* (fr. L. *proprius* own, particular) + *spinal*] : distinctively or exclusively spinal (a ~ reflex)

